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Tomoyuki Ito

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EXAMINER

MONDT, JOHANNES P

ART UNIT

PAPER NUMBER

3663

| SHORTENED STATUTORY PERIOD OF RESPONSE | MAIL DATE | DELIVERY MODE |
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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

|                              |                        |                     |  |
|------------------------------|------------------------|---------------------|--|
| <b>Office Action Summary</b> | <b>Application No.</b> | <b>Applicant(s)</b> |  |
|                              | 10/767,397             | ITO ET AL.          |  |
|                              | <b>Examiner</b>        | <b>Art Unit</b>     |  |
|                              | Johannes P. Mondt      | 3663                |  |

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 13 November 2006.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-29 is/are pending in the application.
- 4a) Of the above claim(s) 1-10, 15-20 and 24-29 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 11-14 and 21-23 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                       | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>11/13/06</u> .  | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Response to Amendment***

Amendment filed 11/13/06 forms the basis for this office action. In said Amendment applicant substantially amended all elected claims at least through substantial amendment of independent claim 11 and 21. Comments on Remarks are included below under "Response to Arguments".

### ***Information Disclosure Statement***

The examiner acknowledges Information Disclosure Statement filed 11/13/06 and returns a signed copy of Form PTO-1449. However, examiner notes a mismatch between Name (of Patentee or Inventor) on the one hand and Document No. and Date on the other hand. Although the item as listed based on Document Number and Date listing Yasuda as first inventor has been considered, the item as listed cannot be considered, for which reason said Form PTO-1449 has not been initialed for said item.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

1. ***Claims 11-14 and 21-23*** are rejected under 35 U.S.C. 102(b) as being anticipated by Paillaman et al. (US 2002/0080905 A1). The following rejections are subject to the noted indefiniteness under 35 USC 112 overleaf. In the

rejections “appropriate” as an adjective is assumed to have no patentable weight while the vertical axis is assumed to pertain to the claimed body.

*On claim 11: Paillaman et al teach* (title, abstract, Figures 1-6 and [0020]-[0040]) an apparatus 82 ([0026] and Figure 3) capable of executing an operation in a vessel 10 (Figure 1 and [0020]) of a nuclear reactor, comprising: a body 84 ([0026]-[0027] and Figure 3) capable of being suspended and lowered into the vessel; a tool 140 ([0026]-[0027] and Figure 4) attached to the body capable of at least one of repairing and inspecting (namely: inspecting, “inspection tool”) an interior of a pump 34 ([0020]-[0025] and Figure 2) in the vessel; a guide 120 ([0029] and Figure 4) and supported at a lower portion of the body (see Figure 3), the guide 120 having an inclined surface with respect to a vertical axis (the vertical axis being the axis of elongate frame member 86 of apparatus 82; see Figure 3 and [0027]).

Said guide is capable of having an inclined surface with respect to a vertical axis of the body when the body is suspended (see, e.g., [0028] on drive cable 112), while the guide is movably supported at a lower portion of the body, either by the very tip beyond the segment indicated by 120 in Figure 3, or by drive cable 112, depending on the direction defined as “vertical”.

Furthermore, the limitation “when the body is suspended, wherein the guide movably supported at a lower portion of the body so that the inclined surface of the guide is first inserted into the pump when the body is suspended and lowered into the vessel” is purely functional language, limiting intended use rather than the structure of the apparatus. In reference to the claim language referring to the portion cited above,

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intended use and other types of functional language must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In re Casey, 152 USPQ 235 (CCPA 1967); In re Otto, 136 USPQ 458, 459 (CCPA 1963). In the underlying case, Paillaman et al teaches a guide 120 supported as claimed as discussed above, which by virtue of the drive cable 112 ([0028]) is capable of having an inclined surface (note its flexibility as disclosed), while the specifics of the pump do not belong to the apparatus and pertains exclusively to an object to which said apparatus may be applied. Said apparatus is capable of being applied to said pump when the body is suspended, depending only on the direction of gravitation, and is capable of being lowered into the body when said body has an opening as described, again because of the drive cable 112.

*On claim 12:* the guide 120 includes at least one of a guide rod and a guide surface first portion 124 coupled to second portion 126 by flexible U-joint 128, and, in an alternative identification: and/or probe sub-assembly 130 coupled to second portion 126 by second flexible U-joint 132; see [0029] and Figure 4) inclined at an angle with respect to a vertical axis (i.e., the vertical axis being the axis of elongate frame member 86 of apparatus 82; see Figure 3 and [0027]). Whether this angle is "appropriate" is a matter of use and hence of functional language: In reference to the claim language referring to "appropriate", intended use and other types of functional language must result in a structural difference between the claimed invention and the prior art in order

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to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In re Casey, 152 USPQ 235 (CCPA 1967); In re Otto, 136 USPQ 458, 459 (CCPA 1963).

*On claim 13:* the guide 120 is freely supported at the lower portion of the body 84 (attached to it with one free end; see Figure 4) and is capable to be inclined at an angle (please note the flexible U-joints; see Figure 6 and [0029]-[0032]) with respect to a vertical axis (the vertical axis being the axis of elongate frame member 86 of apparatus 82; see Figure 3 and [0027]). Whether this angle is "appropriate" is a matter of use and hence of functional language: In reference to the claim language referring to "appropriate", intended use and other types of functional language must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In re Casey, 152 USPQ 235 (CCPA 1967); In re Otto, 136 USPQ 458, 459 (CCPA 1963). Finally, a gravitational force is inherent and thus is a force on the guide contributing to its orientation and hence its angle.

*On claim 14:* the guide is by virtue of the flexibility of the joints biased to return to an equilibrium position with respect to the body. Whether this position is "appropriate" is a matter of use and hence of functional language: In reference to the claim language referring to "appropriate", intended use and other types of functional language must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure

is capable of performing the intended use, then it meets the claim. In re Casey, 152 USPQ 235 (CCPA 1967); In re Otto, 136 USPQ 458, 459 (CCPA 1963).

*On claim 21:* Paillaman et al teach (title, abstract, Figures 1-6 and [0020]-[0040]) an apparatus 82 ([0026] and Figure 3) capable of executing an operation in a pressure vessel 10 (Figure 1 and [0020]) of a nuclear reactor, comprising:

- a body 84 ([0026]-[0027] and Figure 3) capable of being suspended and lowered into the vessel;

- a tool 140 ([0026]-[0027] and Figure 4) attached to the body capable of at least one of repairing and inspecting (namely: inspecting, "inspection tool") an interior of a pump 34 ([0020]-[0025] and Figure 2) in the pressure vessel 10;

- a guide 120 ([0029] and Figure 4) and supported at a lower portion of the body (see Figure 3), the guide 120 capable of having an inclined surface with respect to a vertical axis (the vertical axis being the axis of elongate frame member 86 of apparatus 82; see Figure 3 and [0027]) when the body is suspended and the guide is inserted into an opening in the pump. Whether or not such inclined surface actually occurs under the stated conditions is a matter of use and is not of patentable weight in the present apparatus invention. In reference to the claim language referring to "when the body is suspended and the guide is inserted into an opening in the pump", intended use and other types of functional language must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In re Casey, 152 USPQ 235 (CCPA 1967); In re

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Otto , 136 USPQ 458, 459 (CCPA 1963). Parenthetically it is noted that in use the body is indeed suspended and the guide is inserted into an opening in the pump ([0031]-[0036]).

Said guide is capable of having an inclined surface with respect to a vertical axis of the body when the body is suspended (see, e.g., [0028] on drive cable 112), while the guide is movably supported at a lower portion of the body, either by the very tip beyond the segment indicated by 120 in Figure 3, or by drive cable 112, depending on the direction defined as "vertical" as either approximately down or approximately up..

Furthermore, the limitation "when the body is suspended, wherein the guide movably supported at a lower portion of the body so that the inclined surface of the guide is first inserted into the pump when the body is suspended and lowered into the vessel" is purely functional language, limiting intended use rather than the structure of the apparatus. In reference to the claim language referring to the portion cited above, intended use and other types of functional language must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In re Casey, 152 USPQ 235 (CCPA 1967); In re Otto , 136 USPQ 458, 459 (CCPA 1963). In the underlying case, Paillaman et al teaches a guide 120 supported as claimed as discussed above, which by virtue of the drive cable 112 ([0028]) is capable of having an inclined surface, while the specifics of the pump do not belong to the apparatus and pertains exclusively to an object to which said apparatus may be applied. Said apparatus is capable of being



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applied to said pump when the body is suspended, depending only on the direction of gravitation, and is capable of being lowered into the body when said body has an opening as described, again because of the drive cable 112.

Finally, the tapering surface of an opening as claimed is a tapering surface an opening of an object (pump) to which the apparatus is applied, while the tapering nature of said opening surface is no way inhibits the application of the apparatus by Paillaman et al because the drive cable enables the guide to be inserted at an angle. Once again, the tapering surface of said opening limits an object to which the apparatus is applied and hence constitutes functional language failing to limit the invention of the apparatus as explained above for the same reasons, said same reason herewith being included by reference.

*On claim 22:* the guide 120 is freely supported at the lower portion of the body 84 (attached to it with one free end; see Figure 4) and is capable to be inclined at an angle (please note the flexible U-joints; see Figure 6 and [0029]-[0032]) with respect to a vertical axis (the vertical axis being the axis of elongate frame member 86 of apparatus 82; see Figure 3 and [0027]). Whether this angle is "appropriate" is a matter of use and hence of functional language: In reference to the claim language referring to "appropriate", intended use and other types of functional language must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In re Casey, 152 USPQ 235 (CCPA 1967); In re Otto, 136 USPQ 458, 459 (CCPA 1963). Finally, a gravitational

force is inherent and thus is a force on the guide contributing to its orientation and hence its angle.

*On claim 23:* the guide is by virtue of the flexibility of the joints biased to return to an equilibrium position with respect to the body. Whether this position is "appropriate" is a matter of use and hence of functional language: In reference to the claim language referring to "appropriate", intended use and other types of functional language must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In re Casey, 152 USPQ 235 (CCPA 1967); In re Otto, 136 USPQ 458, 459 (CCPA 1963).

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. **Claims 11-14 and 21-23** are rejected under 35 U.S.C. 102(e) as being anticipated by Ganoza et al. (US 2003/0085301 A1). The following rejections are provided subject to the noted indefiniteness under 35 USC 112 overleaf.

*Ganoza et al teach* (title, abstract, Figures 1-5 and 8, and [0017]-[0039]) an apparatus 80 (Figures 4-5 and 8) for executing an operation in a vessel of a nuclear reactor (a cleaning operation is a special case of an operation), comprising:

a body 84 capable of being suspended and lowered into the vessel 10 ([0017]) (N.B.: the cleaning device is lowered into the vent inlet 66 of the inlet mixer 40 in said pressure vessel 10(see Figures 1-2 and 4-5, and [0018]-[0021]);

a tool 92 ([0021] and Figures 4-5 and 8) attached to the body (see Figures 4-5) capable of at least one of repairing and inspecting an interior of a pump 34 ([0017]) in the pressure vessel 10 (N.B.: cleaning is a special case of repairing); and

a guide 100 supported at a lower portion of the body (see Figure 8 in conjunction with Figures 4-5); the guide having an inclined surface with respect to a vertical axis (see Figures 4-5 and 8, and [0023]).

In reference to the claim language referring to an apparatus “for executing an operation in a vessel of a nuclear reactor”, and to a tool “for at least one of repairing and inspecting”, intended use and other types of functional language must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. *In re Casey*, 152 USPQ 235 (CCPA 1967); *In re Otto*, 136 USPQ 458, 459 (CCPA 1963).

Said guide is capable of having an inclined surface with respect to a vertical axis of the body when the body is suspended (see, e.g., the inclined surface as disclosed in Figures 4 and 5 and their discussion in [0020]-[0024]) while the guide is movably supported at a lower portion of the body, when the body is suspended as depicted in said Figures 4-5, i.e., with the body hanging down rather than up.

Furthermore, the limitation "when the body is suspended, wherein the guide movably supported at a lower portion of the body so that the inclined surface of the guide is first inserted into the pump when the body is suspended and lowered into the vessel" is purely functional language, limiting intended use rather than the structure of the apparatus. In reference to the claim language referring to the portion cited above, intended use and other types of functional language must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In re Casey, 152 USPQ 235 (CCPA 1967); In re Otto, 136 USPQ 458, 459 (CCPA 1963). In the underlying case, Ganoza et al teaches a guide 100 supported as claimed as discussed above, which by virtue of the suspension through 84 and 82 ([0021]-[0022]) is capable of having an inclined surface (note its flexibility at least to a certain extent is implied by the bent form implying spring function), while the specifics of the pump do not belong to the apparatus and pertains exclusively to an object to which said apparatus may be applied. Said apparatus is capable of being applied to said pump when the body is suspended,

depending only on the direction of gravitation, and is capable of being lowered into the body when said body has an opening as described.

*On claim 12:* the guide 100 includes at least one of a guide rod and a guide surface (namely bends 102, which are part of a tubing section, and hence meet the limitation “rod” and also the limitation “surface”; see [0023]) inclined at an angle with respect to a vertical axis (“vertical axis” being parallel to tube section 82; see Figures 4-5).

*On claim 13:* the guide 100 is freely supported at the lower portion of the body 84 (i.e., attached at one end only) (Figure 4) and inclined with respect to a vertical axis (main axis of 84 or main axis of 82; see Figure 4). Whether this angle is “appropriate” is a matter of use and hence of functional language: In reference to the claim language referring to “appropriate”, intended use and other types of functional language must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In re Casey, 152 USPQ 235 (CCPA 1967); In re Otto, 136 USPQ 458, 459 (CCPA 1963). Parenthetically, as evidenced from Figure 8 the angle is suitably flexible for insertion of the body 84 into the jet pump 34. Finally, a gravitational force is inherent and thus is one of the forces on the guide, and hence contributes to its orientation and its angle.

*On claim 14:* the guide 100 is part of tubing section 82, which is made of metal ([0021]). It is inherent to metal to be flexible to some degree so that when forced out of equilibrium, it returns to equilibrium. Furthermore, the limitation “to return to an

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appropriate position with respect to the body” implies a method of use limitation and as such constitutes functional language. In reference to the claim language referring to “to return to an appropriate position with respect to the body”, intended use and other types of functional language must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. *In re Casey*, 152 USPQ 235 (CCPA 1967); *In re Otto*, 136 USPQ 458, 459 (CCPA 1963).

*On claim 21:* Ganoza et al teach (title, abstract, Figures 1-5 and 8, and [0017]-[0039]) an apparatus 80 (Figures 4-5 and 8) for executing an operation in a pressure vessel 10 of a nuclear reactor (a cleaning operation is a special case of an operation), comprising:

a body 84 capable of being suspended and lowered into the vessel 10 (N.B.: the cleaning device is lowered into the vent inlet 66 of the inlet mixer 40 in said pressure vessel 10 (see Figures 1-2 and 4-5, and [0018]-[0021]);

a tool 92 ([0021] and Figures 4-5 and 8) attached to the body (see Figures 4-5) capable of at least one of repairing and inspecting an interior of a pump 34 ([0017]) in the pressure vessel 10 (N.B.: cleaning is a special case of repairing); and

a guide 100 supported at a lower portion of the body (see Figure 8 in conjunction with Figures 4-5); the guide capable of being inclined with respect to a vertical axis (see Figures 4-5 and 8, and [0023]) when the body is suspended (as is the case in Figure 8) and the guide is inserted into an opening 66 (Figure 8 and [0021]) in the pump.

Said guide is capable of having an inclined surface with respect to a vertical axis of the body when the body is suspended (see, e.g., the inclined surface as disclosed in Figures 4 and 5 and their discussion in [0020]-[0024]) while the guide is movably supported at a lower portion of the body, when the body is suspended as depicted in said Figures 4-5, i.e., with the body hanging down rather than up.

Furthermore, the limitation "when the body is suspended, wherein the guide movably supported at a lower portion of the body so that the inclined surface of the guide is first inserted into the pump when the body is suspended and lowered into the vessel" is purely functional language, limiting intended use rather than the structure of the apparatus. In reference to the claim language referring to the portion cited above, intended use and other types of functional language must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In re Casey, 152 USPQ 235 (CCPA 1967); In re Otto, 136 USPQ 458, 459 (CCPA 1963). In the underlying case, Ganoza et al teaches a guide 100 supported as claimed as discussed above, which by virtue of the suspension through 84 and 82 ([0021]-[0022]) is capable of having an inclined surface (note its flexibility at least to a certain extent is implied by the bent form implying spring function), while the specifics of the pump do not belong to the apparatus and pertains exclusively to an object to which said apparatus may be applied. Said apparatus is capable of being applied to said pump when the body is suspended,

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depending only on the direction of gravitation, and is capable of being lowered into the body when said body has an opening as described.

Finally, the tapering surface of an opening as claimed is a tapering surface an opening of an object (pump) to which the apparatus is applied, while the tapering nature of said opening surface is no way inhibits the application of the apparatus by Paillaman et al because the drive cable enables the guide to be inserted at an angle. Once again, the tapering surface of said opening limits an object to which the apparatus is applied and hence constitutes functional language failing to limit the invention of the apparatus as explained above for the same reasons, said same reason herewith being included by reference.

*On claim 22:* the guide 100 is freely supported at the lower portion of the body 84 (i.e., attached at one end only) (Figure 4) and inclined with respect to a vertical axis (main axis of 84 or main axis of 82; see Figure 4). Whether this angle is "appropriate" is a matter of use and hence of functional language: In reference to the claim language referring to "appropriate", intended use and other types of functional language must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In re Casey, 152 USPQ 235 (CCPA 1967); In re Otto, 136 USPQ 458, 459 (CCPA 1963). Parenthetically, as evidenced from Figure 8 the angle is suitably flexible for insertion of the body 84 into the jet pump 34. Finally, a gravitational force is inherent and thus is one of the forces on the guide, and hence contributes to its orientation and its angle.



*On claim 23:* the guide 100 is part of tubing section 82, which is made of metal ([0021]). It is inherent to metal to be flexible to some degree so that when forced out of equilibrium, it returns to equilibrium. Furthermore, the limitation "to return to an appropriate position with respect to the body" implies a method of use limitation and as such constitutes functional language. In reference to the claim language referring to "to return to an appropriate position with respect to the body", intended use and other types of functional language must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. *In re Casey*, 152 USPQ 235 (CCPA 1967); *In re Otto*, 136 USPQ 458, 459 (CCPA 1963).

### ***Response to Arguments***

Applicant's arguments filed 11/13/06 have been fully considered but they are not persuasive. The amendment fails to overcome the art rejections made in the previous office action because the added claim language to the extent not met is merely functional. In particular:

(1) Although the rejections under 35 USC 112, first paragraph, and the rejections under 35 USC 112, second paragraph have been overcome by amendment, examiner makes of record herewith that "vertical axis of the body when the body is suspended" implies only an approximate alignment with the direction of the gravitational force, because the body is subject to other potential forces depending on how the body is suspended.

(2) Paillaman et al teaches guide 120 to be supported at a lower portion of the body (depending on how one holds the apparatus, either the tip portion extending beyond 120 or element 112). Furthermore, the limitation "when the body is suspended, wherein the guide movably supported at a lower portion of the body so that the inclined surface of the guide is first inserted into the pump when the body is suspended and lowered into the vessel" is purely functional language, limiting intended use rather than the structure of the apparatus. In reference to the claim language referring to the portion cited above, intended use and other types of functional language must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In re Casey, 152 USPQ 235 (CCPA 1967); In re Otto, 136 USPQ 458, 459 (CCPA 1963). In the underlying case, Paillaman et al teaches a guide 120 supported as claimed as discussed above, which by virtue of the drive cable 112 ([0028]) is capable of having an inclined surface, while the specifics of the pump do not belong to the apparatus and pertains exclusively to an object to which said apparatus may be applied. Said apparatus is capable of being applied to said pump when the body is suspended, depending only on the direction of gravitation, and is capable of being lowered into the body when said body has an opening as described, again because of the drive cable 112. Therefore, the rejection of claim 11 over Paillaman et al must be made to stand. With regard to claim 21 the tapering surface of an opening as claimed is a tapering surface an opening of an object (pump) to which the apparatus is applied, while the tapering nature of said opening

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surface is no way inhibits the application of the apparatus by Paillaman et al because the drive cable enables the guide to be inserted at an angle. Therefore, the rejection of claim 21 over Paillaman et al must be made to stand as well.

(3) *Similar considerations pertain to Ganoza et al* in that a guide 100 being movably supported at a lower part of the body (by a connector piece to body 84 such as element 102 or element 104), "lower" acquiring meaning depending on the orientation with regard to a reference system in which a preferred direction is singled out to denote the direction parallel to the unit vector in the lower direction. Furthermore, the limitation "when the body is suspended, wherein the guide movably supported at a lower portion of the body so that the inclined surface of the guide is first inserted into the pump when the body is suspended and lowered into the vessel" is purely functional language, limiting intended use rather than the structure of the apparatus. In reference to the claim language referring to the portion cited above, intended use and other types of functional language must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In re Casey, 152 USPQ 235 (CCPA 1967); In re Otto, 136 USPQ 458, 459 (CCPA 1963). In the underlying case, given a pump with a correct angle for the opening in which the inclined surface of the guide (Figure 4) is to be inserted, the inclined surface of the guide can be inserted into the pump when the body (84) is suspended and lowered into the vessel. Hence the apparatus of Ganoza et al is capable of performing the claimed

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function. Therefore, the rejection over Ganoza et al have not been overcome by amendment.

### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. See list provided in the previous office action, said list being included herewith by reference.

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Johannes P. Mondt whose telephone number is 571-272-1919. The examiner can normally be reached on 8:00 - 18:00.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jack W. Keith can be reached on 571-272-6878. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

JPM  
February 5, 2007

Primary Examiner:

A handwritten signature in black ink, appearing to read 'J. Mondt', is written over the printed name.

Johannes Mondt (TC 3600, Art Unit: 3663)